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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,009	01/08/2004	Manabu Matsubara	51766/DBP/A400	7159
23363	7590	08/22/2006	EXAMINER	
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			KAPLAN, HAL IRA	
			ART UNIT	PAPER NUMBER
			2836	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/754,009

Applicant(s)

MATSUBARA ET AL.

Examiner

Hal I. Kaplan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004 and 28 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 6,9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/28/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The disclosure is objected to because of the following informalities: Page 13, lines 28-29 contain the phrase "the process returns to S6". It appears this should be "the process returns to S5" (see Figure 5).

Appropriate correction is required.

4. The disclosure is objected to under 37 CFR 1.71(b) because it does not completely describe a specific embodiment of the processes of the invention. It appears that the processes shown in Figures 6, 8, and 10 require a step in which the counter is initialized ($C_{n-1} = 0$) before the steps in which it is determined whether the codes match. Neither the specification nor the drawings disclose an initialization step.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the interrogation signal output section, engine start permitting section, engine start signal outputting section, code outputting section, activation signal outputting section, and match/mismatch judging section must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "11" has been used to designate both the key transponder (see page 7, lines 2-5) and the alternator output terminal (see page 14, lines 6-10) in Figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claims 1-12 are objected to because of the following informalities: The relationships between the different sections referred to in claims 1-12 are unclear. It is

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not clear what happens and in what order when a user puts a key in the key cylinder or presses the start button on the remote commander, or which devices have what sections. It is also unclear what exactly the "signal related to engine starting" is or when and how it is generated.

In addition, claims 1, 5, and 6 all claim an interrogating signal outputting section of the immobilizer. It is unclear whether these refer to different interrogating signal outputting sections or the same section. Similarly, claim 7 claims two different engine start permitting sections within the immobilizer. In both cases, the examiner has assumed they refer to the same section. Claim 5, lines 9-10 and claim 6, lines 24-25 read "said immobilizer includes an interrogating signal output section which outputs". It appears this should read "said interrogating signal outputting section outputs". Appropriate correction is required.

Claim 1, line 5 contains the word "staring". It appears this should be "starting".

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the US patent of Hayashi et al. (5,912,512).

As to claim 1, Hayashi, drawn to an engine start control apparatus, discloses a

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remote control engine starting device for a vehicle having an immobilizer and a remote engine starter and equipped with a remote engine starting function for starting an engine when an engine start command is given from a remote location, wherein the immobilizer (12) comprises an interrogating signal outputting section which outputs an interrogating signal (TXCT) when a signal related to engine starting (KWS-on-signal) is received (see column 9, lines 3-28), and an engine start permitting section which gives engine start permission when a remote engine starter code (CODE) that the remote engine starter (54) outputs in response to the interrogation signal (TXCT) matches a remote engine starter verifying code preregistered in the immobilizer (12) (see column 9, lines 12-28 and 51-55; and column 10, lines 19-43 and 61-67), and the remote engine starter (54) comprises an engine start signal outputting section which outputs a signal related to engine starting, and a code outputting section (70) which, in response to the interrogating signal (TXCT), outputs the remote engine starter code (CODE) preregistered in the remote engine starter (54) (see column 9, lines 3-5 and 24-28).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi in view of the Japanese patent application of Yasuo (08-15902).

As to claim 2, Hayashi discloses all of the claimed features, as set forth above, except for a remote commander code. Yasuo, drawn to an engine starter, discloses a remote commander code (ID code) transmitted from a remote commander (1), wherein when the remote commander code (ID code) matches a remote commander verifying code preregistered in the remote engine starter (5,15), the engine start signal outputting section (15) of the remote engine starter (5,15) outputs a signal related to engine starting (engine start permission signal). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the system of Hayashi by adding

the remote commander code comparison functionality Yasuo, in order to provide additional and more robust theft protection.

As to claims 3-4, Hayashi in view of Yasuo disclose a remote starter code and remote commander verifying code, as set forth above, with no specific limitations on whether they are the same or different. Therefore it is inherent that they can be either the same code or different codes.

14. Claims 5, 7, 8, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi in view of the US patent of Tado et al. (5,973,411).

As to claims 5, 7, and 8, Hayashi discloses all of the claimed features, as set forth above, except for an activation signal outputting section. Tado, drawn to an apparatus for protecting motor vehicle against unauthorized operation, discloses an immobilizer (3A,5A) comprising an activation signal outputting section which outputs an activation signal to a key cylinder (2) when a signal related to engine starting (SG) is received (see column 7, line 66 through column 8, line 3), and an engine start permitting section which receives a key code output from a key in response to the activation signal, and which gives engine start permission when the key code matches a preregistered code (see column 8, lines 6-44). As set forth above, the interrogation section of the immobilizer of Hayashi outputs an interrogating signal when a signal related to engine starting is received, regardless of whether an IG key insertion signal is received. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the system of Hayashi to include the functionality of Tado, in order to provide additional and more robust theft protection.

As to claims 11 and 12, the engine start permitting section of the immobilizer of Tado does not give engine start permission when the remote engine starter code has failed to match the remote engine starter verifying code a predetermined number (upper limit) of times (see column 8, lines 45-58).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US patents to Linton et al. (5,684,338), Iijima et al. (5,708,307), Schweiger (5,818,330), Hisada et al. (6,043,752), Kito et al. (6,188,140), Kikkawa et al. (6,788,189), and Yanaka (6,816,059), and the Japanese patent application publication of Shimogoori et al. (2002-293216), disclose similar antitheft systems.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal I. Kaplan whose telephone number is 571-272-8587. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on 571-272-2800 x36. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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